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AFTER FINAL – EXPEDITED PROCEDURE

**PETITION TO THE DIRECTOR
REGARDING PREMATURE FINAL REJECTION (MPEP § 706.07(c))**

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I. Introduction.....	1
II. Questions Presented	4
III. Final Rejection of Claim 87 is Premature, and the Technology Center SPrE Erred By Acting “Contrary To” Established Agency Precedent.....	5
A. Facts relating to Claim 87	5
B. Legal Standard for the “New Ground of Rejection” Element of Final Rejection	7
C. First Ground for Reversal: Under the Undisputed Facts, The New Positions and Rationales in the 10/25/04 Office Action, the 2/14/05 Advisory Action, and the 6/14/05 Advisory Meet the Legal Definition of “New Ground”	9
D. Conclusion: Claim 87 Was Not Timely Examined, and Neither Examiner Ellis nor The 11/8/05 Decision Have Decided Otherwise	10
IV. The Status of Claim 22 is Too Unclear to Permit Appeal or Closure of Prosecution	10
A. Procedural History of Claim 22	10
B. Applicable Law	12
C. Fourth Ground for Reversal: Breach of 37 C.F.R. §§ 1.104(c)(2) and MPEP § 707.07(f) Have Been Breached, and Therefore Claim 22 is not Rejected at All; Because There is No “Clear Statement of Reasons,” Final Rejection is Premature	13
V. The 11/9/05 Decision Fails to Adjudicate a Number of Issues Fairly and Squarely Presented, and Displays Major Misunderstandings of Legal Processes	15
VI. Conclusion	17
VII. 7	
VIII. Procedural History	7

Petitioner seeks review of a Decision on Petition rendered November 8, 2005. The ultimate relief requested is withdrawal of finality and/or entry of an Amendment filed April 25, 2005, and an order to the Examiner to examine the application timely and on paper, in the manner required by 37 C.F.R. § 1.104, MPEP Chapter 2100, and Federal Circuit instructions on examination procedure.

I. Introduction

Rarely does a PTO official state that he/she considers the written law to be not “helpful,” that he refuses to apply the law simply because he “cannot see” why he should, and then state that he makes up his own interpretations on the spot, refusing to consider court or agency authority. This is such a remarkable case. In a written Decision, T.C. Director Jack Harvey states that he decides “**Contrary to the ... case law**,” simply because “it cannot be seen” why the law should be applied (Decisions of 9/9/05 at 5, 11/8/05 at 5), and his stated reason is almost verbatim the proposition rejected by the Federal Circuit. In a telephone interview seeking reconsideration of this Decision and attempting to bring this recent Federal Circuit decision to his attention, T.C. Director Harvey stated that he interprets the law on his own, without regard for court precedent or the PTO’s established procedures (Interview Summary filed Nov 28, 2005, IFW 12/1/05, 7-page document captioned “Transmittal to TC”, attached as Exhibit 1 to this paper). He stated that he regards Federal Circuit authority and PTO precedent as not “helpful” and that he would not even consider it, *id.*, even though the MPEP expressly refers the reader to the case law.

The original problem is that examination has been untimely. For example, the first Office Action in this application dealt with 88 claims in a 4-page Office Action. Though the application has been pending for over six years, no Office Action has yet stated the examiner’s position on every independent claim. It is impossible to identify the basis of disagreement with the examiner, because the examiner sits mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection. The examiner has repeatedly withheld a statement of his views until post-final advisory actions, and when revealed, these views are so *outré* that no reasonable person could possibly have guessed at them before they were set to paper. Even

though he plainly admits in his advisory actions that entire paragraphs of his Office Actions were miscopied from predecessor documents (Advisory of 2/14/05 at ¶ 5) and that his Actions omitted the intended discussion, he insists on maintaining finality. In order to avoid withdrawing finality, he has advanced increasingly strained excuses, including that a number retains its value when its order is reversed (that is, the number “1234” is equal to “4321”), that the claim term “necessarily” allows for exceptions, so that “necessarily disjoint” covers situations that permit overlap (Advisory of 3/27/2003 ¶ 1, Action of 10/1/2002 ¶ 31(F)), that a grandparent application is not entitled to priority under 35 U.S.C. § 120 (Advisory of 6/14/05 at pp. 3-5), and technological views that are characterized in an expert’s Declaration as “impossible” and “unreasonable” (09/626,325, Affidavit of David R. Levine, filed 12/14/05). He has several times squarely stated that he will not follow instructions set out by the Director in 37 C.F.R. and the MPEP (Action of 2/10/03 ¶ 4 – Examiner states that he is exempt from MPEP § 2143.02 because non-chemical inventions “always” have “reasonable expectation of success”).

In combination, these support an inference of deliberate obstruction by the examiner, an issue beyond this petition.

After a number of telephone interviews with the examiner, SPE Eddie Chan, and T.C. Stewart Levy, premature finality has been petitioned twice.¹ This Petition arises out of the second, on which decisions were rendered 9/9/05 and 11/8/05.

¹ In the Decision on a 2003 Petition (5/30/03), the T.C. Director Levy overruled the Director’s instruction in MPEP § 706.07(c) (final rejection is petitionable), and stated that premature final rejection is not petitionable. Decision of 5/30/03. The only “authority” cited for this remarkable view of the Director’s duties is MPEP § 1201, which says nothing relevant. The Decision admits that the Office Actions “did not specifically discuss the limitations” of several of the independent claims. Decision of 5/30/03 at 3, lines 34-35. Even after acknowledging this fault, the Decision holds that there is no mechanism for seeking enforcement of any rule that regulates examiner conduct relating to claims, during examination under 35 U.S.C. § 131/§ 132. Decision of 5/30/05 at 4-5. The Decision also holds that no entity in the Patent Office will ever review whether an examiner has examined an application in accordance with PRO rules before the Office awards the examiner a production “count.” *Id.* The implication of the 5/30/03 Decision is that the PTO rewards examiners for not examining applications in accordance with the rules, insofar as incomplete examination is easier, and forces applicants into RCE’s that generate more “counts.”

The Decision closes off the only other avenue for seeking enforcement of these rules, in view of the Board’s oft-repeated statement that it has no supervisory authority over examiners, Board of Patent Appeals, Frequently Asked Questions web page, www.uspto.gov/web/offices/dcom/bpai/bpaifaq.htm, “Answer to Question 8”; *Ex parte Gambogi*, 62 USPQ 1209, 1212 (BPAI 2002) (“We decline to tell an examiner precisely how to set out a rejection”); *see also Ex parte Johnson*, 2001 WL 1857256,

The Decision of 9/9/05 made a number of remarkable statements. First, the 9/9/05 Decision states that it is acting “**Contrary to**” CCPA precedent, simply because the author “cannot see” why the CCPA ruled as it did. Second, the Decision fails to address the issues presented: where the Petition seeks relief for breaches of 37 C.F.R. §§ 1.104, 1.113, and 1.116(b), MPEP § 706.07, MPEP § 706.07(a), MPEP § 2143.02, and Federal Circuit procedural law, the Decision cites only MPEP § 706.07(a), and misquotes even that², as if the author thought that so long as the PTO follows one law, it is free to ignore all other laws. The Decision does not even acknowledge the existence of the formal Rules of Practice of 37 C.F.R. or the petition grounds raised thereunder. Third, the Decision states a number of legal propositions without citing any authority – for example, “**there is no requirement [for an] identification between the claims and reference(s) be provided to applicant in the grounds of rejection set forth in the examination process**” (Decision of 9/9/05, page 5, lines 1-3).

In a telephone interview of 10/30/2005 and an email of 11/1/2005, this attorney and T.C. Director Harvey discussed these and several other defects in the Decision. It was agreed that the Decision of 9/9/05 was withdrawn, and a new decision would be issued. (Interview Summary filed 11/28/05, Exhibit 1.)

Remarkably, even though T.C. Director Harvey was made aware of the defects cataloged above, and Petitioner provided a fairly substantial exposition of the relevant case law in a Supplement to Petition of 10/31/05 (which was in the hands of T.C. Director Harvey by no later than 11/1/05, see FAX cover sheet, confirming that the FAX was received at SPrE Johnson’s personal FAX on 10/31/05), and Director Harvey had promised that he would look up the

<http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd000873.pdf> at 5 (BPAI Mar. 13, 2001) (unpublished) (“We exercise no general supervisory power over the examining corps.”), and has no jurisdiction to resolve issues that question an examiner’s compliance with procedural provisions of 37 C.F.R. § 1.104 or the MPEP. *Ex parte Haas*, 175 USPQ 217, 220 (Bd. Pat. App. 1972) (“If the examiner fails to follow the Commissioner’s directions in the M.P.E.P., appellant’s remedy is by way of petition to the Commissioner since this Board has no jurisdiction over the examiner’s action.”) (Lidoff, examiner-in-chief, concurring), *rev’d on other grounds*, 486 F.2d 1053 (CCPA 1973).

This 2003 Decision was vacated as moot by a subsequent decision of the Petitions Office.

² MPEP § 706.07(a) states that the “new ground of rejection” rule only comes into play when all other prerequisites of “present practice” have been satisfied. This was specifically pointed out in the Petition.

definition of “new ground of rejection,” the Decision rendered a week later – 9/8/05 – is apparently verbatim identical. The 9/8/05 Decisions fails to “answer all material traversed,” and fails to make any attempt to correct the errors pointed out in the communications of 10/30/05, 10/31/05 and 11/1/05.

II. Questions Presented

The Decision of 9/8/2005 should be vacated or reversed for at least the following reasons:

1. Did T.C. Director Harvey act arbitrarily, capriciously, and contrary to law?

Yes. The 9/8/05 Decision admits that it is “Contrary to … case law.” It fails to decide issues presented. It makes up new propositions of law and creates novel exceptions to rules with no citation to authority. It interprets the MPEP in a manner inconsistent with 37 C.F.R. It disregards agency precedent.

2. Is the consideration of claims 87 and 104 (which were not amended in any relevant respect after the Office Action of February 2004) in the Office Action of October 2004 timely to support closing of prosecution?

No. First, under controlling precedent, a “new ground of rejection” arises when a subsequent paper “is factually based on an entirely different portion of an existing reference” relative to an earlier paper. The October 2004 paper relies on new portions of the reference, and therefore introduces a new ground of rejection of an unamended claim. Second, the Office Action of February 2004 raised no rejection at all – it was absolutely silent on all limitations of claim 87. Because of this omission from the February 2004 Action, any rejection raised in the October Office Action is necessarily a “new” ground. Advisory Actions expressly admit that consideration of claim 104 was lacking from the Office Actions. Claims 87 and 104 may not be finally rejected.

3. Does the Office Action of October 2004 timely comply with the requirements of 37 C.F.R. § 1.113 for final rejection of claim 22?

No. Rule 113 requires that any final Office Action “clearly” state the reasons for rejection. The October 2004 Office Action hints that the examiner has shifted from a single reference to a combination of references to meet a claim limitation, but the newly-applied references and portions thereof are not identified in the Office Action. Even in the Advisory Action, the portions relied on are not designated, and no pertinence is explained. An examiner may not prematurely close prosecution by playing “hide the ball.”

4. May the Amendment of 4/25/2005 be entered pursuant to 137 C.F.R. § 1.16(b)(3)?

Yes. Neither the examiner or the T.C. Director dispute that there are “good and sufficient reasons why the amendment is necessary and was not earlier presented.”

III. Final Rejection of Claim 87 is Premature, and the Technology Center SPrE Erred By Acting “Contrary To” Established Agency Precedent

An Action may not be made final when it introduces a new ground of rejection, where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

A. Facts relating to Claim 87

As of October 2004, claim 87 recited as follows:

87. A method, comprising the steps of:

executing a **control-transfer instruction** under a first execution context of a computer, the instruction being **architecturally defined to transfer control directly to a destination instruction** for execution in a second execution context of the computer;

before executing the destination instruction, altering the data storage content of the computer to establish a program context under the second execution context that is logically equivalent to the context of the computer as interpreted under the first execution context, the reconfiguring including at least one data movement operation not included in the architectural definition of the control-transfer instruction.

Since its original filing in 1999, claim 87 has recited a “control-transfer instruction of a computer … architecturally defined to transfer control directly to a destination instruction.”

Claim 87 is the only claim that recites anything analogous to this limitation.

The February 2004 Office Action (paper no. 38) makes a summary statement that claim 87 is rejected, but nowhere actually states a rejection in the manner required by 37 C.F.R. § 1.104 and MPEP § 2141-2143.03. The sum total discussion of claim 87 is as follows:

46. Claims 3, 15-16, 18-19, 21-33, 42-47, 49-50, 54-59, 69, 73-85, 87-93, 96-103, 110-112, 116-126, and 133 are rejected under 35 USC § 103 as being unpatentable over Goetz et al., U.S. Patent 5,854,913, in view of Brender et al., U.S. Patent 5,339,422 and Murphy et al., U.S. Patent 5,764,947 (incorporated by reference into Brender et al. at col. 1 lines 10-12 and 19-24).

100. As to claims 87-93, 96-103, 110-112, 116-117, 118-126, and 133, they do not teach or define above the invention claimed in the previously rejected respective claims and are therefore rejected under Goetz et al. in view of Brender et al. and Murphy et al. for the same reasons set forth in the previous claim rejections, supra.

There is no dispute that the February 2004 Action does not designate “the particular part relied on” of any reference, or “explain the pertinence” of any reference, as required by 37 C.F.R. § 1.104(c)(2), or set forth any of the other required *prima facie* elements of any rejection of claim 87. There is likewise no dispute that the February 2004 Office Action never designates any reference or portion thereof as corresponding to the “control transfer instruction” of claim 87 (or any other claim, because this instruction is not recited in any other claim) to any reference.

In Petitioner’s paper of July 12, 2004, Petitioner noted the silence of the Office Action with respect to claim 87, and that this silence represented a failure to raise any rejection whatsoever. Response of 7/12/04 at 36-37.

The October 2004 Office Action partially filled the silence of the earlier Action. The sum total of the discussion of claim 87 in October 2004 is as follows:

14.4. That: "Claim 87 recites "executing a control-transfer instruction ... architecturally defined to transfer control directly to a destination instruction". . . . Further, Brender '422 teaches that the control transfer instruction must transfer control to the jacket, not "directly to a destination instruction" as recited in claim 87".

This is not found persuasive because Brender et al. does indeed indicate that the control-transfer instruction is "architecturally defined to transfer control directly". See col. 15 lines 48-50: "In the present embodiment, it is based on the fact that a direct X call to a Y routine incurs an X operand fault". Accordingly, Brender et al. indicates that the call is "architecturally defined" to transfer "directly". Brender et al.'s system simply intervenes to convert between the expected data storage conventions of the two routines.

There is no dispute that this paragraph 14.4 is the first mention in the entire prosecution history of col. 15, lines 48-50 of the Brender reference, or anything relating to the subject matter discussed there. There is likewise no dispute that neither the February 2004 nor the October 2004 Office Action has ever set out a rejection in even minimal conformance with 37 C.F.R. § 1.104 and MPEP §§ 2141-2143.03 by “designating” the portions relied on and “clearly explaining” the pertinence.

The Examiner’s paper of February 14, 2004 is absolutely silent in response. There is no dispute that the Examiner failed to “answer all material traversed” as required by MPEP

§ 707.07(f). Neither the Examiner nor the T.C. Director have pointed to anything that in any way suggests the Examiner's view of the showing of January 2005.

B. Legal Standard for the “New Ground of Rejection” Element of Final Rejection

The fundamental dispute is over the definition of the term “new ground of rejection.” The T.C. Director stated in the interview that he believes the definition is “same statute, same references.” He cites no authority whatsoever. All authority is contrary.

MPEP § 706.07(a) reads as follows, in pertinent part:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims...

MPEP § 706.07(a) imposes two separate requirements before prosecution may be closed: (a) all requirements of “present practice” must be timely completed, and (b) no new ground of rejection may be raised, unless necessitated by amendment.

The MPEP expressly directs that the definition of the term “new ground of rejection” must be sought in the case law. MPEP § 1207.03(III) (directing the reader to see the line of case law exemplified by *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)). The legal term “new ground of rejection” is defined as any “position or rationale new to the proceedings” (new evidence, citation to a new portion of existing evidence, a new inference drawn from an existing reference, a new legal theory, a new application of law to facts).³ For example, relying on a new portion of an existing reference is a “new ground of rejection.” *In re Wiechert*, 370 F.2d 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) (“An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of

³ *In re DeBlauwe*, 736 F.2d 699, 706 n. 9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984) (“Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence”), *citing* 37 C.F.R. § 1.196(b); *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976); *In re Eynde*, 480 F.2d 1364, 1370-71, 178 USPQ 470, 474 (CCPA 1973) (“We do agree with appellants that where the board advances a position or rationale new to the proceedings... the appellant must be afforded an opportunity to respond to that position or rationale by the submission of contradicting evidence.”).

an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference").⁴ A new supporting position or rationale is a "new ground," even if it is simply offered to buttress a previous analysis or inference.⁵ Any notion that a "new ground" requires a new reference or shift from one statutory section to another has been expressly rejected by the Federal Circuit, the CCPA, by the Commissioner (now Director), and by the Board, as recently as August 2005.⁶

This flows from basic principles of examination: it is always the examiner's duty to take the first step of stating all elements of a *prima facie* case of unpatentability.⁷ For example, 37 C.F.R. § 1.104(c)(2) states that it is the examiner's duty in the first instance to designate the portions relied upon "as nearly as practicable," and "clearly explain" the correspondence of any complex reference to any claim being rejected, at least on the facts here.⁸ The courts and the Board have noted that Applicants cannot, and therefore are not obligated to, respond to issues that the examiner has not raised. *See* 37 C.F.R. § 1.111(b) (response must "point[] out the

⁴ *See also In re Echerd*, 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA 1973) ("We find the new reliance [to be] a new ground of rejection. New portions of the reference are relied upon to support an entirely new theory... appellants should have been accorded an opportunity to present rebuttal evidence as to the new assumptions of inherent characteristics made by the board"), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427.

⁵ *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1051 (Fed. Cir. 2005) (a new calculation applied to a reference is not "simply an additional explanation of the Board's decision," it is a new ground of rejection); *In re Waymouth*, 486 F.2d 1058, 1061, 179 USPQ 627, 629 (CCPA 1973) ("merely advanc[ing] 'an additional reason' for affirming the examiner" is a "new rejection"), *modified* 489 F.2d 1297, 180 USPQ 453 (CCPA 1974), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427; *Ex parte Hanlon*, Appeal No. 98-2033, 1998 WL 1748535 at *2-3, .../fd982033.pdf (Board's different analysis of the same portion of the same reference is a "new ground of rejection").

⁶ *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1051 (Fed. Cir. 2005); *In re Ahlert*, 424 F.2d 1088, 1098, 165 USPQ 418, 421 (CCPA 1970) (new facts based on an existing reference are a new ground of rejection); *In re Intine*, 162 USPQ 192, 192 (Comm'r of Patents 1969); *see also* cases cited in "Supplement to Petition" of 10/31/05.

⁷ 37 C.F.R. §§ 1.104, 1.113 (actions must be "complete" and "clearly state" reasons); MPEP § 2142 (burden rests with examiner to "show" unpatentability); *Wiechert*, 370 F.2d at 963-64, 152 USPQ at 251-52, *citing* 37 C.F.R. § 1.106, now § 1.104(c)(2); *see also In re Oetiker*, 977 F.2d 1443, 1449 (Fed. Cir. 1992) (Plager, J., concurring) ("The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner.").

⁸ *See also Wiechert*, 370 F.2d at 963-64, 152 USPQ at 251-52 ("This point seems to be appreciated by the Patent Office itself as its Rule [now 1.104(c)(2)] provides, *inter alia*, that: "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable."").

supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action" – no duty to go beyond the written action). The rules provide only one procedural mechanism for an examiner when an applicant's arguments or evidence require a new position or rationale: non-final rejection.

C. New Positions and Rationales in the 10/25/04 Office Action, the 2/14/05 Advisory Action, and the 6/14/05 Advisory Meet the Legal Definition of "New Ground"

Final rejection is premature under the "new ground of rejection" provision of MPEP § 706.07(a).⁹ This case is even clearer than in any of the cases discussed above: in this case, the Examiner was absolutely silent on the claim limitation at issue. The new art cited is not only a shift or supplement to a previous position, it is the first statement of any position whatsoever on the relevant claim limitation.

The undisputed facts are that the Action of February 2004 was absolutely silent on the "control transfer instruction" of claim 87. It is also undisputed that col. 15, lines 48-50 of the Brender reference, and the "direct X call to a Y routine" discussed there, were first "designated" in the Office Action of October 2004, the Office Action that is subject of this petition. Both Examiner Ellis and SPrE Johnson were challenged to identify any corresponding "ground" in the February 2004 Action, and were unable to do so. Indeed, the 11/8/05 Decision expressly admits that the Action of October 2004 raises new grounds, when it states "the Examiner responded directly (in the Final rejection of October 25, 2005) to Applicant's arguments by pointing out where the argued feature was taught" (Decision of 9/9/05, at 5 lines 12-14), and is unable to show any antecedent for this showing in the February 2004 Action.

The 11/8/05 Decision makes up a totally new test for "new ground of rejection" – excusing any "further clarifying one's position and responding directly to limitations identified as 'not taught by the cited art'"¹⁰ (Decision of 11/8/05, at 5 lines 16-17); *contra Kumar*, 418

⁹ To avoid any doubt, Petitioner notes that the issue of this § III.C arises under MPEP § 706.07(a), second sentence, not the fourth sentence, which relates to "newly cited art."

¹⁰ The Decision of 11/9/05 makes up facts: this phrase is not used in Petitioner's papers. The issues petitioned do not relate to issues "not taught by the cited art," they relate to issues not discussed in the Office Actions.

F.3d at 1367, 76 USPQ2d at 1051 (“simply an additional explanation” is still a “new ground”). The 11/8/05 Decision cites no authority for this new test. It cannot be affirmed.

Even on the T.C. Director’s test, the October 2004 Action raises a “new ground:” an examiner’s first statement of any view on an issue is not “further clarifying,” it is a “new ground.”

On the facts admitted by both the Examiner and the 11/8/05 Decision, final rejection was premature.

D. Conclusion: Claim 87 Was Not Timely Examined, and Neither Examiner Ellis nor The 11/8/05 Decision Have Decided Otherwise

Examination of claim 87 is untimely. At best, the October Action raises a new ground of rejection not necessitated by any amendment. Under MPEP § 706.07(a), finality of the Action of October 2004 is premature.

IV. The Status of Claim 22 is Too Unclear to Permit Appeal or Closure of Prosecution

The Petition of 4/8/05 (as supplemented 6/14/05) raises several related issues as to claim 22, all arising under 37 C.F.R. § 1.113(b) and MPEP § 706.07: the Examiner himself has already conceded that the October 2004 Action is too incomplete to support final rejection. The Decision of 11/8/05 is absolutely silent on the issue presented. Instead, the Decision appears to be directed to an issue under MPEP § 706.07(a), relating to “new ground of rejection” (*see* Decision of 11/8/05, statement of issues decided, page 3, second item). No decision was rendered, and none can be affirmed.

A. Procedural History of Claim 22

Claim 22 is discussed at paragraph 52 of the Office Action of the February 2004 and paragraph 14 of the October 2004 Office Action. Claim 22 recites as follows:

22. A method, comprising the steps of:

executing instructions fetched from first and second regions of a memory of a computer, the instructions of the first and second regions being coded for execution by computers following first and second data storage conventions, the memory regions having associated first and second indicator elements, **the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed;**

recognizing when program execution has flowed or transferred from a region whose indicator element indicates the first data storage convention to a

region whose indicator element indicates the second data storage convention, and in response to the recognition, altering the data storage content of the computer to create a program context under the second data storage convention that is logically equivalent to a pre-alteration program context under the first data storage convention.

Paragraph 52.4 of the February 2004 Action compares the “the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed” to only Goetz '913, col. 17, lines 24-33 and to no other reference (¶ 52.3 and 52.5 also only mention the Goetz '913 reference, making clear that Examiner Ellis is relying exclusively on one reference for this portion of the claim):

52. As to claim 22, Goetz et al. in view of Brender et al. and Murphy et al. taught:
52.4. the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed (Goetz et al. col. 17 lines 24-33);

The October 2004 Action states that the Examiner has shifted from the single Goetz reference to another, and that because of that shift, “references may not be attacked individually.” However, the October 2004 Office Action does not even specify which other references might be involved, let alone “designate the portions relied on” (Action of October 2004, page 3 ¶ 14.1):

14.1. That: “Paragraph 52.4 compares the “the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed” to Goetz, col. 17, lines 24-33. However, here, Goetz only teaches a P bit that indicates an instruction set. There is no indication that Goetz ever uses two different “data storage conventions” as recited in claim 22, let alone indicates them with any “indicator.”

This is not found persuasive because applicant is arguing against the references separately. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Paragraph 4 of the 2/14/2005 Advisory Action further confuses the issues: it merely states that unspecified portions of one or both of two other references might be used to

supplement the Goetz '913 patent, in some unspecified way, to meet the specific claim limitation at issue:

4. **"No "Clear Issue" Is Developed for Claim 22"**

Applicant is additionally in error in this statement. If applicant were to have referred to the rejection of claim 22 at paragraph 52 of the February 2004 office action, he would have recognized that the rejection of claim 22 was based upon a combination of references, specifically Goetz et al. in view of Brender et al. and Murphy et al. He would also have recognized from the rejection that although Goetz et al. contained the claimed indicators (52.4) that it was Brender et al. and Murphy et al. which provided the teaching of "data storage convention" portion of this particular claim. Therefore, by arguing that Goetz et al. alone did not teach the complete claimed aspect, applicant was indeed arguing the references individually, and as such, the response given was exactly that which was necessary to rebut applicant's argument.

The June 2005 Advisory Action offers no further clarification of what the Examiner's position is today.

B. Applicable Law

The basic requirements for raising any rejection in the first instance, apart from any question of "finality," are set out at page 16, above, including 37 C.F.R. § 1.104(c)(2), and *In re Brouwer*.

37 C.F.R. § 1.113 sets out the minimum requirements for a final rejection. Rule 113 reads as follows:

37 C.F.R. 1.113. Final rejection or action.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

MPEP § 706.07 elaborates on § 1.113 as follows, emphasis added:

706.07 Final Rejection

Before final rejection is in order a clear issue should be developed between the examiner and applicant. . . .

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

....

In making the final rejection, all outstanding grounds of rejection ... must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply.

C. 37 C.F.R. §§ 1.104(c)(2) and MPEP § 707.07(f) Have Been Breached, and Therefore Claim 22 is not Rejected at All; Because There is No "Clear Statement of Reasons," Final Rejection is Premature

The October 2004 Office Action articulates no clear position on claim 22. As set out more fully in the Appeal Brief filed 11/28/05, the Examiner's position is so muddled and self-contradictory that no response or appeal is possible. Because the Office Actions do not meet the requirements of 37 C.F.R. § 1.113(b) ("In making such final rejection, the examiner shall ... clearly [state] the reasons in support thereof."), MPEP § 706.07 ("any such grounds relied on in the final rejection ... must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal"), prosecution may not be closed.

Until the Examiner complies with "applicable departmental regulations," including 37 C.F.R. § 1.104, the Office Actions are "illegal and of no effect." *Accardi v. Shaughnessey*, 359 U.S. 535, 545 (1959); *Schroeder v. West*, 212 F.3d 1265, 1269-70 (Fed. Cir. 2000). Claim 22 is not rejected. A non-rejection cannot mature into a final rejection.¹¹

The 11/8/05 Decision fails to adjudicate the issue presented, and decides a totally different issue. Section III of the Petition invokes 37 C.F.R. §§ 1.113(b) and 1.104(c)(2), and MPEP § 706.07 (not § 706.07(a)). None of these rules mention "new ground of rejection." Yet, in setting out the issues purportedly decided. the 11/8/05 Decision recasts the issue onto another legal footing (Decision 11/8/05 at 3):

Does the Final Office action of October 25, 2004 timely comply with 37 CFR §1.113 for final rejection of unamended claim 22, i.e. no new grounds of rejection.

¹¹ This failure to comply with applicable regulations also operates to prevent finality under MPEP § 706.07(a). For example, § 706.07(a) reads "Under present practice, second ... actions shall be final, except ..." If examination has not met the requirements of "present practice," then the remainder of the sentence simply does not apply.

The body of the Decision never mentions any of the rules cited by the Petition, or any of the requirements set forth there. Indeed, it specifically denies that any such requirements exist. *E.g.*, where 37 C.F.R. § 1.104(c)(2) requires a “designation” and “explanation” of the references, the 11/8/05 Decision states “there is no requirement [for an] identification between the claims and reference(s) be provided to applicant in the grounds of rejection set forth in the examination process” (Decision of 9/9/05, page 5, lines 1-3).

Because the Decision fails to require the examiner to examine as required by 37 C.F.R. §§ 1.104 and 1.113, it vitiates rules of the PTO, and is unlawful. It should be reversed.

III. The Examiner Himself Conceded that the 10/2004 Action is not “Complete” as to Claim 104, and the 11/8/05 Decision Does Not Disagree. Final Rejection is Premature.

The Supplement of June 14, 2005 notes the Examiner’s concession that the October 2004 Action is too incomplete to support final rejection. The February 2004 Action discusses claim 104 under § 102 over a single reference:

10.	Claims 1-2, 4-14, 17, 37-47, 51-53, 61-66, 68, 70-72, 104-109, 113-115, and 128-132 are rejected under 35 USC § 102(e) as being clearly anticipated by Goetz et al., U.S. Patent 5,854,913.
42.	As to claim 104-109, 113-115, 128-132, they do not teach or define above the invention claimed in the previously respective rejected claims and are therefore rejected under Goetz et al. for the same reasons set forth in the previous claim rejections, <u>supra</u> .

Petitioner’s July 2004 paper notes two things: (a) there is no element-by-element comparison of claim 104 to any reference, and claim 104 recites a limitation (“first and second data storage conventions”) not present in other claims. Without some showing that the reference meets this limitation, applicants are unable to respond precisely. (b) Second, and as a separate issue, the “first and second data storage conventions” language distinguishes the portions of the Goetz reference designated by the Office Action.

The October 2004 Action reads as follows:

14.7. That: "Claim 104 recites two memory regions that "[follow] first and second data storage conventions." As discussed above in connection with claim 22, at page 34, there is no indication that Goetz '913 uses two different "data storage conventions."

This is not found persuasive because applicant is arguing against the references separately. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the Advisory of 2/14/05, Examiner Ellis writes:

3. "Claim 104 has Not Been Examined"

Applicant is in error in this statement. Claim 104 was examined, and was rejected, in paper number 38, mailed February 11, 2004, at paragraph 42. Claim 104 is rejected with Goetz et al. in the exact same manner as claim 4 (as claim 4 existed on February 11, 2004, due to the fact that claim 104 is simply a restatement of claim 4 (as claim 4 existed on February 11, 2004). A fact that applicant should have been immediately aware of because applicant himself wrote the claims. Accordingly, claim 104 was rejected.

Applicant is additionally confused because paragraph 14.7 of the Office Action of October 2004 contains a copy of the response from paragraph 14.1 regarding claim 22. This was a typographical mistake in the office action of October 2004. The correct response was:

Goetz et al. taught using "the instructions ... following first and second data storage conventions" at col. 15 lines 45-49.

The October Action clearly shifted grounds, from a single references to an unidentified combination. This is a "new ground of rejection," which prevents finality under MPEP § 706.07(a). The Advisory of 2/14/05 admits that the October 2004 Action was not "complete" as required by 37 C.F.R. § 1.113(b). For two separate reasons, final rejection is premature.

V. The 11/9/05 Decision Fails to Adjudicate a Number of Issues Fairly and Squarely Presented, and Displays Major Misunderstandings of Legal Processes

The 11/8/05 Decision steps far out of bounds: by its own admission, it states that the test for "new ground of rejection" is "Contrary to the citations of case law presented by Petitioner," quotes back the CCPA's own language from *In re Wiechert* and *In re Kronig*, and states that it will not be applied. (Decision of Sept 8, 2005, at 5 lines 15-17). T.C. Directors lack the authority to act "contrary to" the law. *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) ("An agency is not free to refuse to follow circuit precedent."). The September 2005 Decision should be vacated.

Those who decide Petitions are obligated to decide the issues presented. Separate grounds may not be ignored, and the issues may not be redefined. *E.g., In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005) (“In accordance with the Administrative Procedure Act, the agency must assure that an applicant’s petition is fully and fairly treated at the administrative level, without interim need for judicial intervention.”).

Section I.D of the April 2005 Petition raises a separate ground based on the Examiner’s failure to comply with 37 C.F.R. § 1.104(c)(2), and the requirement for showings with “specificity,” *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), noting first that the Action of February 2004 is inadequate to raise any rejection, and that therefore, any rejection raised in October 2004 was necessarily “new.” The 11/8/05 Decision is apparently silent: at most it notes is that paragraph 46 (quoted at page 5, above) conclusorily “identified” a rejection (Decision of Sept 2005, page 5, lines 9-10). “Identifying” a rejection is not the same thing as setting out a “cogent explanation” that “considers every important aspect” of an issue, as required by the Supreme Court, and is not the same thing as “designating” all portions of a reference relied on, and clearly explaining the “pertinence” as required by 37 C.F.R. § 1.104(c)(2).

Section I.E of the April 8, 2005 Petition (pages 6-7) raises a separate ground for withdrawing finality based on MPEP §§ 2142-2143.03. The September 2005 Decision on Petition is absolutely silent.

37 C.F.R. § 1.113 and MPEP § 706.07 instruct that final rejection is only permissible when an examiner’s position on each individual claim is articulated in a single paper, and his position on the application as a whole is set out in no more than two. This issue was squarely raised (Petition of 4/8/05 at 9, first full paragraph), the 11/8/05 Decision is silent.

The 11/8/05 Decision is totally silent on the issue discussed in § III above, except to note that a rejection of claim 104 is “identified,” not set forth as required by the rules. More “identification” of a rejection is not sufficient to raise a rejection, let alone final.

Entry of the Amendment of 4/25/05 was sought under Rule 116(b)(3). The 11/8/05 Decision discusses facts such as “previously presented,” “cursory review,” “additional claims without canceling” that may be relevant under Rule 116(b)(1) and (2), but have nothing to do

with whether amendments are admissible under Rule 116(b)(3).¹² The time for the PTO to render a decision under 37 C.F.R. § 1.116(b)(3) is past, and the PTO failed to act within the appropriate time. Accordingly, the Amendment of 4/25/05 is entered by operation of law.

At several points, the Decision promotes the MPEP over formal rules in 37 C.F.R. As a matter of administrative law, the PTO has expressly renounced any intention to make the MPEP binding against any party but itself. MPEP Forward (MPEP “does not have the force of law.”) The 11/8/05 Decision erred by using the MPEP to erode rights granted to applicants by 37 C.F.R.

The 11/8/05 Decision states: “The rejections presented and explanations provided by the Examiner are not read in a vacuum, but rather with an understanding and-knowledge of one having ‘ordinary skill in the art’ (MPEP 2106).” (Decision of Sept 2005, page 5, lines 18-20). MPEP § 2106 is absolutely silent on how applicants are to read examiners’ explanations. This is just one example of the outright confabulation that pervades the Decision.

The 11/8/05 Decision states, without citing any authority, “there is no requirement [for an] identification between the claims and reference(s) be provided to applicant in the grounds of rejection set forth in the examination process.” (Decision of Sept 2005, page 5, lines 1-3). The 11/8/05 Decision makes no attempt to explain or distinguish 37 C.F.R. § 1.104(c)(2), which does require exactly such an identification, and 37 C.F.R. § 1.113(b), which requires that all grounds be stated “clearly,” or the Federal Circuit precedent cited above that does require examiners to set forth “findings” on the teachings of the prior art. *e.g.*, *In re Berg*, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003).

VI. Conclusion

For these reasons, the finality of the Action of October 2004 should be withdrawn. Prosecution should be reopened, and the Amendment filed April 25, 2005 should be entered as of right (even without a showing of reasons under Rule 116). In the alternative, the Amendment of April 125, 2005 should be entered pursuant to 37 C.F.R. § 1.116(b)(3). In either case, and in addition, Examiner Ellis should be instructed that he will not receive a disposal “count” until he

¹² Rule 116 was amended in August 2004. The Advisory cover sheet is a version from 11/03. To the degree that the advisory cover sheet suggests that it is permissible to exclude an amendment on the basis that it “raises new issues that would require further consideration and/or search,” regardless of a showing under Rule 116(b)(3), the cover sheet is obsolete and superseded by the amendment to Rule 116.

mails two Office Actions that fully and fairly treat all claims (at the very least, all independent claims) pending in the application, setting forth factual and legal findings on all issues instructed by the Director in 37 C.F.R. § 1.104, and MPEP Chapters 700 and 2100.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,
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